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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,311	03/01/2002	Daniel Lee Briley	10992014-1	8556

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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JABR, FADEY S

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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09/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,311	<b>Applicant(s)</b> BRILEY, DANIEL LEE	
	<b>Examiner</b> Fadey S. Jabr	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,14-23,25-31,33-38,40-42 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11,14-23,25-31,33-38,40-42 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 August 2007 has been entered.

### ***Status of Claims***

Claims 2-3 and 12-13 have been cancelled per this amendment. Claims 1, 11, 21, 29, 37 and 41 have been amended. Claims 1, 4-11, 14-23, 25-31, 33-38, 40-42 and 44 remain pending and are again presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed 1 August 2007 have been fully considered but they are not persuasive.

3. Applicant argues that Leon does not disclose information including in a non-visible portion of the postage indicia is used as a key to decode the information in the visible portion of the postage indicia. However, Examiner notes that Leon discloses human-readable information and machine-readable information (e.g., encoded/signed data, identifiers, micro printing, and so on). Both forms of information can be used to determine the authenticity of the affixed mark...The information detected by these elements is passed to a computer that analyzes,

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verifies, and authenticates the information retrieved from the postage label...Computer may also authenticate the postage information by comparing the decoded data with the unencoded data from the postage label (C. 13, lines 13-42). Further, Leon discloses each taggant bead has multicolored layers that are arranged in a color pattern to encode information (C. 14, lines 19-20). Thus, Leon discloses validating the postage information and indicia using (Claim 1). Thus, Leon discloses encoding information in the non-visible portion and comparing it to the unencoded data from the postage label to determine its validity.

4. Applicant argues that Leon fails to disclose using retrieved information to generate postage information. However, Examiner notes that Leon discloses a marking reader that detects one or more identifiers in an identifier portion of the postage label. The computer receives information from the readers and provides a status signal that indicates whether the postage label is authentic (C. 3, lines 4-8). Therefore, Leon discloses generates security information from the retrieved information.

5. Applicant argues that Leon fails to disclose that the authentication system processes non-visible information by scanning the non-visible information with a combination of one or the other of UV and IR scanning as is presently claimed. However, Examiner notes that the claim merely recite scanning the non-visible marks using an UV or an IR light... Further, Leon discloses elements in the indicia can be printed using various types of ink including visible and invisible...or any combination thereof...The ink can also be invisible to the human eye under white light (or daylight) and become apparent only under light of specified wavelength(s) such as UV light...Detection devices can be used to detect the existence and contents of the printed materials, i.e., to authenticate the indicia (C.9, lines 14-25). Therefore, Leon discloses

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processing invisible information by using a scanning device to detect the invisible information, such as a UV light, as claimed by the applicant.

6. Applicant argues that the combination of both UV and IR produces advantages which are not suggested at all in Leon. However, Examiner notes that the applicant merely claims scanning using UV or IR light, not both.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **1 4-11, 14-23, 25-31 and 33-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Patent No. 6,701,304 B2, hereinafter referred to as Leon.

As per **Claims 1 and 11**, Leon discloses a method for postage label authentication comprising:

- receiving the mail piece (C. 13, lines 18-33);
- scanning the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks, wherein the non-visible marks are scanned using an Ultra Violet (UV) light, and wherein the non-visible marks are also detectable by human eye using a UV light (C. 9, lines 14-25, C. 13, lines 18-42); and

- processing the visible mark information and the non-visible mark information to generate postage information for the mail piece (C. 2, lines 21-62, C. 3, lines 4-8).

Leon fails to *explicitly* disclose that wherein the non-visible marks are also detectable by human eye using a UV light *for human confirmation of the non-visible marks*. However, Leon discloses the ink can also be invisible to the human eye under white light and become apparent only under light of specified wavelength(s) such as UV light (C. 9, lines 14-25). Further, the system of Leon is concerned with detecting the invisible ink in the indicia.

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claims 1 and 11, including UV light is disclosed by Leon as described above. Also, as described above, the functional limitations in claims 1 and 11 do not distinguish the claimed apparatus from the prior art.

As per Claims 4, 14, 22 and 30, Leon further discloses processing the non-visible mark information to validate the postage evidence (C. 9, lines 23-25).

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As per **Claims 5, 15, 23 and 31**, Leon further discloses wherein the non-visible mark information comprises a key to the visible mark information (C. 11, line 63 – C. 12, line 7, C. 13, lines 13-42, C. 14, lines 19-20);

As per **Claims 7, 17, 25 and 33**, Leon further discloses wherein the visible marks and the non-visible marks comprise a bar code (C. 2, lines 35-46).

As per **Claims 8, 18, 26 and 34**, Leon further discloses wherein the visible marks and the non-visible marks comprise Information Based Indicia (IBI) (C. 7, lines 51-55).

As per **Claims 9, 19, 27 and 35**, Leon further discloses wherein the postage information includes a postage amount (See Figure 4).

As per **Claims 10, 20, 28 and 36**, Leon further discloses wherein the postage information includes a data, an origination address, a destination address, and security information (C. 12, lines 16-67; also see Figure 4).

As per **Claims 6, 16, 21 and 29**, Leon further discloses a method comprising:

- printing visible marks on the mail piece (C. 2, lines 21-62); and
- printing non-visible marks on the mail piece, wherein the visible marks and the non-visible marks indicate the postage evidence for the mail piece, wherein the non-visible marks are scanned using an Ultra Violet (UV) light, and wherein the non-

visible marks are also detectable by human eye using a UV light (C. 2, lines 21-62, C. 9, lines 14-25, C. 13, lines 18-42).

Leon fails to disclose wherein the visible marks and the non-visible marks are printed based on a *checksum* algorithm. However, Leon discloses one or more fields in the indicium can be encoded with a particular encryption algorithm (e.g., DES, RSA, or a *comparable algorithm*) or signed using a particular cryptographic or digital signature algorithm (e.g., DSA, RSA, or a *comparable algorithm*), or both (C. 11, line 63 – C. 12, line 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Leon and include comparable algorithms, because it provides the system with a plurality of algorithms to process the postage information.

Leon fails to *explicitly* disclose that wherein the non-visible marks are also detectable by human eye using a UV light *for human confirmation of the non-visible marks*. However, Leon discloses the ink can also be invisible to the human eye under white light and become apparent only under light of specified wavelength(s) such as UV light (C. 9, lines 14-25). Further, the system of Leon is concerned with detecting the invisible ink in the indicia.

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claims 21 and 29, including UV light is disclosed by Leon as described above. Also, as described



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above, the functional limitations in claims 21 and 29 do not distinguish the claimed apparatus from the prior art.

9. Claims **37-38, 40-42** and **44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon in view of Berson et al., U.S. Patent No. 6,039,257, hereinafter referred to as Berson.

As per Claims 37 and 41, Leon discloses a method comprising:

- printing a visible bar code on the mail piece (C. 2, lines 21-62; also see Figure 4); and
- wherein the non-visible marks are scanned using an Ultra Violet (UV) light, and wherein the non-visible marks are also detectable by human eye using a UV light (C. 2, lines 21-62, C. 9, lines 14-25, C. 13, lines 18-42).

Leon fails to disclose printing a non-visible bar code on the mail piece within white space on the visible bar code, wherein the visible bar code and the non-visible bar code indicate the postage evidence for the mail piece. However, Berson et al. discloses the use of an invisible ink to print a bar code “over, or as a part of the IBI” creates additional security (C. 2, lines 24-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to modify the method of Leon and include printing the invisible bar code over or as part of the IBI as taught by Berson et al., because it provides the system with additional security for authenticating the mail piece.

Leon fails to disclose wherein the visible marks and the non-visible marks are printed based on a *checksum* algorithm. However, Leon discloses one or more fields in the indicium can be encoded with a particular encryption algorithm (e.g., DES, RSA, or a *comparable algorithm*)

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or signed using a particular cryptographic or digital signature algorithm (e.g., DSA, RSA, or a *comparable algorithm*), or both (C. 11, line 63 – C. 12, line 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Leon and include comparable algorithms, because it provides the system with a plurality of algorithms to process the postage information.

Leon fails to *explicitly* disclose that wherein the non-visible marks are also detectable by human eye using a UV light *for human confirmation of the non-visible marks*. However, Leon discloses the ink can also be invisible to the human eye under white light and become apparent only under light of specified wavelength(s) such as UV light (C. 9, lines 14-25). Further, the system of Leon is concerned with detecting the invisible ink in the indicia.

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claims 37 and 41, including UV light is disclosed by Leon as described above. Also, as described above, the functional limitations in claims 37 and 41 do not distinguish the claimed apparatus from the prior art.

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As per Claims 38 and 42, Leon discloses wherein the non-visible bar code indicates a validity of the postage evidence (C. 9, lines 23-25).

As per Claims 40 and 44, Leon discloses wherein the visible bar code and the non-visible bar code comprise Information Based Indicia (IBI) (C. 7, lines 51-55).

### *Conclusion*

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3628

FSJ

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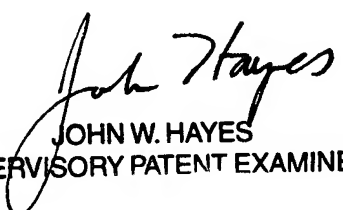
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JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER